

Appl. No. : 09/463,146
Filed : April 14, 2000 .

REMARKS

In the outstanding Office Action, the Examiner has rejected Claims 19-37. Claims 19, 21, 22, 24, 28, 32, and 37 have been amended. No new matter has been added.

Claims 19, 32, and 37 have been amended to specify that the mobile stations comprise a removable module equipped with a decryption function that is arranged to use a decryption key that is common to each of the mobile stations enabled to decrypt the encrypted messages. In addition, amended Claims 19, 32, and 37 include the removable module passing a decrypted message to the mobile station for display. Support for the amendments to the claims can be found in Applicant's specification at page 21, lines 13-15; page 12, line 8 through page 14, line 4; page 21, line 8 through page 22, line 1; page 23, lines 10-14, page 22, lines 2-4; and page 23, lines 14-16. Claims 21, 22, 24, and 28 have been amended in accordance with the amendment to Claim 19.

Thus, Claims 19-37 are presented for further examination. Reconsideration and allowance of all Claims 19-37 in light of the present remarks is respectfully requested.

Discussion of Claim Rejections Under 35 U.S.C. § 102(e)

The Examiner has rejected Claims 19, 20, 24-36, and 37 under 35 U.S.C. § 102(e) as anticipated by WIPO Publication No. WO 96/41493 to Diachina.

In regard to Claims 19, 20, 24, 25, 27-30, 32-34, 36, and 37, the Examiner stated that "Diachina discloses controlling digital control channels for broadcast SMS wherein SMS messages can be encrypted to support different classes of messaging service (access status)", and that "[b]ased on appropriate fee payments, a subscriber would be able to decrypt SMS message of varying classes (preventing and allowing information access, first, second information access status)." The Examiner further stated that "[u]pon payment the mobile stations of the subscribers would be provided with encryption keys for the SMS messages via over the air methods or manual entry of smart cards (removable module) into the mobile stations (Page 40, lines 5-27)."

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053.

Diachina describes a communications system wherein decryption of SMS messages are carried out by processing units in mobile stations. *Page 40, lines 1-3*. Diachina further provides

Appl. No. : 09/463,146
Filed : April 14, 2000 .

that encryption keys or algorithms could be entered directly at the mobile stations via a smart card, and such suggestion is the only mention of a removable module in conjunction with Diachina's communication system. *Page 40, lines 23-24.* Thus, decryption of broadcast messages in Diachina's system occurs in the mobile equipment itself rather than in the smart card.

In contrast to Diachina, the method of amended Claim 19 comprises "arranging for each said removable module of each of said first mobile stations to decrypt said encrypted broadcast message using said common decryption key in response to receipt of said encrypted broadcast message; and arranging for each said removable module to pass said decrypted broadcast message to its corresponding first mobile station for display thereon." Applicant also notes that Diachina similarly fails to teach that "the message is decrypted, using the decryption key, in the removable module" as recited in Claim 19 as examined and prior to the above amendment. Thus, Diachina fails to teach every element of Claim 19 as examined and as amended, and Applicant respectfully submits that the amendment to Claim 19 is not necessary to overcome the rejection of Claim 19 based on Diachina.

Diachina further fails to teach "enabling ... by providing each removable module of each of said first mobile stations with a decryption function arranged to use a decryption key common to each of said first mobile stations", and "arranging for each said first mobile station to pass said encrypted broadcast message to its corresponding removable module"

Thus, as Diachina fails to describe, either expressly or inherently, every feature as recited in amended Claim 19, Applicant respectfully submits Claim 19 for further review as patentable subject matter.

As amended Claims 32 and 37 recite limitations similar to those recited in the method of Claim 19, the arguments with respect to Claim 19 similarly apply to Claims 32 and 37, and thus, Claims 32 and 37 are respectfully submitted for further review as patentable subject matter.

Because Claims 20, 24-31, and 33-36 depend from Claims 19 and 32, pursuant to 35 U.S.C. § 112, ¶ 4, they incorporate by reference all the limitations of the claim to which they refer. It is therefore submitted that these claims are in condition for allowance at least for the reasons expressed with respect to the independent claims, and for their other features.

Appl. No. : 09/463,146
Filed : April 14, 2000.

Discussion of Claim Rejections Under 35 U.S.C. § 103(a)

The Examiner has rejected Claims 21-23 under 35 U.S.C. § 103(a) as being unpatentable over Diachina in view of the publication entitled "Smart Card Technology Applied to the future European Cellular Telephone on the digital D-Network" by Farrugia, et al.

To establish a *prima facie* case of obviousness, the prior art references, when combined, must teach or suggest all the claim limitations. M.P.E.P. § 2143.

In reference to Claims 21-23, the Examiner repeated the argument in regard to Claim 19. As discussed above in reference to Claim 19, Diachina fails to teach all of the elements as recited in the claim. Further in reference to Claims 21-23, the Examiner recognized that "Diachina does not disclose storing the keys on the smart cards in an encrypted form". However, the Examiner stated that "Farrugia discloses the use of smart card technology with cellular networks where the key used to decrypt encrypted cellular message are stored in an encrypted fashion on the smart card of the subscribers mobile terminal (Page 101)." The Examiner argued that it "would have been obvious to one of ordinary skill in the art at the time of the invention was made to encrypt the keys of Diachina on the smart cards in order to control access to the keys as taught in Farrugia (Page 102)."

Applicant respectfully submits that it is unclear how or where Farrugia teaches that "the key used to decrypt encrypted cellular message are stored in an encrypted fashion on the smart card of the subscribers mobile terminal" as argued by the Examiner. In addition, the Examiner has failed to point to a teaching or suggestion of the features recited in Claims 22 and 23 in the prior art of record.

Thus, Applicant respectfully submits that the combination of Diachina and Farrugia fails to teach or suggest every element as recited in Claims 21-23. Furthermore, because Claims 21-23 depend from Claim 19, pursuant to 35 U.S.C. § 112, ¶ 4, they incorporate by reference all the limitations of the claim to which they refer. It is therefore submitted that these claims are in condition for allowance at least for the reasons expressed with respect to the independent claim, and for their other features.

Conclusion

Applicant has endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. Accordingly, amendments to the claims, the reasons therefor, and

Appl. No. : 09/463,146
Filed : April 14, 2000

arguments in support of the patentability of the pending claim set are presented above. In light of the above amendments and remarks, reconsideration and withdrawal of the outstanding rejections is respectfully requested.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: June 10, 2004

By: Tiffany Miller
Tiffany Miller
Registration No. 52,032
Agent of Record
Customer No. 20,995
(619) 235-8550